

REMARKS

Applicants' undersigned attorney thanks the Examiner for her comments in the Office Action mailed 05 August 2004 and in the Advisory Action mailed 18 October 2004. Applicants respectfully request reconsideration of this patent application, particularly in view of the above Amendment and the following remarks. Currently, Claims 19-24 and 30-35 are pending, with Claims 30-33 withdrawn from consideration.

Amendment to the Claims

Claims 19-24 and 34-35 have been examined, with no claims being allowed. Claims 19 and 34 have been amended.

Applicants have amended Claim 19 to include the limitation of the targeted elastic material including a plurality of elastomeric first filaments and a plurality of elastomeric second filaments positioned between two facing layers. Support for this amendment is provided at page 7, lines 4-21, as well as in Figs. 5-8.

Applicants have amended Claim 34 to be consistent with the amendments to Claim 19 from which Claim 34 depends.

No new matter has been added by this Amendment. No additional fee is due for this Amendment because the number of independent claims remains unchanged and the total number of claims also remains unchanged.

Information Disclosure Statement

The Examiner has indicated that images of the references cited in the information disclosure statement filed 07 May 2004 (actually 05 May 2004, originally filed 04 September 2003) are not of record in the file. Pursuant to the Examiner's request, Applicants re-submitted copies of all of the references cited in that particular information disclosure statement, under separate cover, for a third time on 05 October 2004.

Claim Rejections - 35 U.S.C. §103**A. Litchholt et al. in view of Van Gompel et al.**

The rejection of Claims 19-22, 24, and 34-35 under 35 U.S.C. §103(a) as being unpatentable over Litchholt et al. (U.S. Patent 5,503,919, hereinafter “Litchholt”) in view of Van Gompel et al. (EP 0 743 052, hereinafter “Van Gompel”) is respectfully traversed.

Litchholt discloses an elastomeric adhesive foam in a variety of garment applications. Litchholt describes elastic side panel members 90 as operatively associated with the diaper in the ear flaps 88, preferably between the topsheet 24 and the backsheet 26. As pointed out by the Examiner, Litchholt fails to disclose differential extensibility in the form of high tension zones aligned along the waist and leg openings and a low tension zone therebetween.

Litchholt also fails to disclose or suggest two different types of elastomeric filaments aligned with the leg openings and the waist openings to form two high tension zones with a low tension zone therebetween, as recited in Applicants’ Claim 34.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Absent impermissible hindsight, there is no suggestion or motivation to combine the teachings of Litchholt and Van Gompel, or to modify the teachings of these references to achieve Applicants’ claimed invention.

Neither Litchholt nor Van Gompel disclose or suggest targeted elastic materials. Thus, there is no reasonable expectation of successfully combining the teachings of Litchholt and Van Gompel to arrive at Applicants’ claimed disposable garment with the targeted elastic materials incorporated into the garment.

Furthermore, Litchholt specifically teaches away from differential extensibility in the form of high tension zones aligned along the waist and leg openings and a low tension zone therebetween. At Col. 35, line 54 – Col. 36, line 7, Litchholt describes differential extensibility along the longitudinal axis when the side panels are stretched in the lateral direction, and specifically describes achieving a

better abdominal fit by including a degree of *reduced lateral extensibility* in the portion of the elasticized side panel *adjacent to the end edge 64* (i.e., the waist edge) of the diaper 20. Thus, Litchholt teaches away from a high tension zone aligned with the waist opening and a low tension zone between the waist opening and the leg openings.

Another requirement for establishing a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. Neither Litchholt nor Van Gompel, alone or in combination, discloses or suggests the incorporation of a targeted elastic material into side panels, particularly a targeted elastic material consisting essentially of a plurality of two types of elastomeric filaments positioned between two facing layers.

As recognized by the Examiner, Applicants have defined the term "targeted elastic material" ("TEM") at page 7, lines 4-10. More particularly, TEM is a single elastic material or laminate having targeted elastic regions. TEM's include only materials or laminates which are made in a single manufacturing process, and which are capable of exhibiting targeted elastic properties without requiring an added elastic band or layer in the targeted elastic region. TEM's do not include materials having elasticized regions achieved through separate manufacture of an elastic band, and subsequent connection of the elastic band to the underlying material.

As indicated in MPEP 2113, "[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)"

Targeted elastic materials differ markedly from materials having separately manufactured and attached elastic bands. As described at page 20, lines 5-8, of Applicants' specification, a targeted elastic material has the appearance of a homogeneous, integrated material. Furthermore, because the targeted elastic material is manufactured prior to incorporation into a garment, the seams bonding the targeted elastic material to other components necessarily include the elastomeric filaments and the facing layers together as an integral component. In contrast, materials having separately manufactured and attached elastic bands often do not include bonding between the elastic bands and other components of the garment, which results in not only a separate appearance of the elastic bands but also a weaker connection of the elastic bands to the garment.

The manufacturing process described in Litchholt fails to disclose or suggest the manufacture of a targeted elastic material that includes high tension zones with a low tension zone therebetween.

The manufacturing process described in Van Gompel recites separate manufacture of an elastic band, and subsequent connection of the elastic band to the underlying material. Although the elastic band is not activated at the time of attachment, the elastic band is, nevertheless, applied to the underlying material subsequent to manufacture. As described by Van Gompel, the stretchable side members do not include targeted elastic material because the stretchable side members require more than a single manufacturing step to create the stretchable side members.

Thus, Litchholt and Van Gompel, alone or in combination, fail to disclose or suggest the disposable garment comprising the targeted elastic material recited by Applicants.

For at least the reasons given above, Applicants respectfully submit that the invention of Litchholt in view of Van Gompel fails to disclose or suggest Applicants' claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

B. Litchholt et al. in view of Van Gompel et al. in view of Poirier

The rejection of Claim 23 under 35 U.S.C. §103(a) as being unpatentable over Litchholt and Van Gompel as applied to Claim 19 above, and further in view of Poirier (U.S. Patent 5,561,858) is respectfully traversed.

As explained above, Litchholt in view of Van Gompel fails to meet the criteria for establishing a *prima facie* case of obviousness. More particularly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify these references or to combine these references to achieve Applicants' claimed invention. Additionally, there is no reasonable expectation of success in achieving Applicants' claimed invention from the combination of these two references. Furthermore, these references fail to disclose or suggest all of Applicants' claim limitations.

Poirier fails to overcome the deficiencies of Litchholt and Van Gompel. Poirier is relied upon to show obviousness of the applicability of diaper features to swimwear. Thus, Litchholt, Van Gompel, and Poirier, alone or in combination, fail to disclose or suggest the disposable garment comprising the targeted elastic material recited by Applicants.

For at least the reasons given above, Applicants respectfully submit that the invention of Litchholt and Van Gompel in further view of Poirier fails to disclose or suggest Applicants' claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

Applicants believe that this case is now in condition for allowance. If the Examiner feels that any issues remain, then Applicants' undersigned attorney would like to discuss the case with the Examiner. The undersigned can be reached at (847) 490-1400.

Respectfully submitted,



Melanie L. Rauch
Registration No. 40,924

Pauley Petersen & Erickson
2800 West Higgins Road, Suite 365
Hoffman Estates, Illinois 60195
(847) 490-1400
FAX (847) 490-1403